

REMARKS

Claims 16-19, 22-25 and 27-29 remain pending and rejected in the present application. Applicants respectfully request reconsideration of the pending claims.

Claims 16-19, 22-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,911,773 (“Mutsuga”) in view of U.S. Patent No. 5,982,298 (“Lappenbusch”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 25 has been amended to recite, in relevant parts, “a calculation unit configured to calculate a first route from a starting point to a destination, the calculation unit further configured to calculate at least one second route different from the first route, from the starting point to the destination; a reproducing device configured to reproduce the calculated first route and the at least one second route for selection by a user; . . . [and] an input device configured to enable the user to **change at least one of the reproduced first and second routes by enabling the user to (i) mark user-selected road segments not included in the at least one**

of the reproduced first and second routes on the reproducing device, and (ii) incorporate the user-selected road segments into the at least one of the reproduced first and second routes to create at least one altered route, the at least one altered route including the user-selected road segments being selectable by the user for route guidance.” The amended features of claim 25 are fully supported by the specification (see, e.g., Substitute Specification, p. 8, l. 13-23: and p. 15, l. 10-15). The claimed limitations at issue require the following: (1) calculating and displaying at least two different routes between the starting point and the destination; (2) enable the user to mark user-selected road segments not included in the at least one of the reproduced first and second routes on the reproducing device; (3) enable the user to incorporate the user-selected road segments into the at least one of the reproduced first and second routes to create at least one altered route; and (4) the at least one altered route including the user-selected road segments being selectable by the user for route guidance.

In the final Office Action of 9/22/09 and the Examiner’s Answer of 8/30/10, the Examiner has argued that “Mutsuga discloses an input device configured to enable the user to input data to manipulate or change the routes that is selected for guiding the user to travel from a starting point to a destination (see Figures 16-19).” In this regard, Applicants note that Mutsuga (including Figs. 16-19 cited by the Examiner) clearly does not teach or suggest the actual claimed limitation which requires changing one of the previously calculated and reproduced first and second routes between the starting point and the destination by incorporating user-selected road segments not included in the at least one of the reproduced first and second routes; instead, Mutsuga merely teaches that the user may select desired route searching conditions to identify the optimal route that includes a desired facility on the way to the destination, but there is simply no suggestion in Mutsuga that previously calculated and reproduced route may be changed.

Independent of the above, to the extent the Examiner has argued in the final Office Action of 9/22/09 that “Lappenbusch discloses an interactive traffic display and trip planner in which the input device which is the cursor control key is used to change at least one selected route by enabling the user [to] mark the selected road (see column 6, lines 14-37),” the portion of Lappenbusch cited by the Examiner merely discloses that road segments may be highlighted by moving the cursor control, for which highlighted road segments the current traffic description is provided, but the highlighting described in Lappenbusch has nothing to do with the Examiner’s contention that a selected route is changed by marking the selected road, let alone anything to do with the claimed limitation of changing one of the previously calculated and reproduced first

and second routes between the starting point and the destination by **incorporating user-selected road segments not included in the at least one of the reproduced first and second routes.**

On p. 6-7 of the Examiner's Answer of 8/30/10, the Examiner contends that Lappenbusch teaches "the user can manipulate or change at least one of the reproduced first and second routes . . . because: (1) a shortest-time route from a starting location to a destination location is calculated by the user interface and . . . the shortest route is displayed via its display device, [and] (2) the user is able to mark the road segments of the route by highlighting them using the cursor control keys on a keyboard or a mouse." The Examiner specifically contends on p. 7 of the Examiner's Answer that the "user [of Lappenbusch system] is capable to mark the road segments from the shortest route among all possible routes calculated and displayed (see further column 7, lines 11-40)." However, there is no suggestion in Lappenbusch that the calculated shortest route described in col. 7, l. 11-40 may be marked. In this regard, the "trip planning mode" for calculating an optimal route between the starting point and the destination is described in a section of Lappenbusch, i.e., col. 7, l. 11-39, which is completely unrelated to the portion of Lappenbusch cited by the Examiner in connection with the highlighting of the road segments (col. 6, l. 14-37). In any case, merely disclosing that road segments may be **highlighted** has nothing to do with **changing one of the previously calculated and reproduced first and second routes** between the starting point and the destination by **incorporating user-selected road segments not included in the at least one of the reproduced first and second routes**, and there is no suggestion in any section of Lappenbusch that **one of the previously calculated and reproduced routes** between the starting point and the destination may be **changed** by the user's marking of selected road segments.

Independent of the above, there is no suggestion in the overall teachings of Mutsuga and Lappenbusch regarding the claimed feature "**the at least one altered route including the user-selected road segments being selectable by the user for route guidance**," as recited in claim 25.

In view of the foregoing explanation, Applicants submit that the overall disclosure of Mutsuga and Lappenbusch simply cannot support the obviousness rejection of independent claim 25. Accordingly, the rejection of claim 25 and its dependent claims 16-19, 22-24 and 27-29 should be withdrawn.

Respectfully submitted,

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